The compounds possess useful nitric oxide synthetase inhibiting activity, and are expected to be useful in the treatment or prophylaxis of a disease or condition in which the synthesis or over synthesis of nitric oxide forms a contributory part.

Remarks

I. Objection to the Abstract

The abstract has been amended in accordance with the suggestions of the Examiner. It is believed that the new abstract complies with all applicable rules.

II. Rejection of claims 1-28 under 35 U.S.C. § 103(a)

Claims 1-28 are pending in the instant application. Claims 1-28 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Currie et al (WO 95/25717-A1 10-1995) and further in view of Hallinan et al. (US 6,344,483 02-2002). For the following reasons, the rejection is respectfully traversed.

Currie et al. does not teach or suggest the instant compounds.

See MPEP § 2144.08 Obviousness of Species When Prior Art Teaches Genus

> The fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a *prima facie* case of obviousness. *In re Baird*, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994) ("The fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious."); *In re Jones*, 958 F.2d 347, 350, 21 USPQ2d 1941, 1943 (Fed. Cir. 1992) (Federal Circuit has "decline[d] to extract from *Merck* [*& Co. v. Biocraft Laboratories Inc.*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir. 1989)] the rule that... regardless of how broad, a disclosure of a chemical genus renders obvious any species that happens to fall within it."). See also *In re Deuel*, 51 F.3d 1552, 1559, 34 USPQ2d 1210, 1215 (Fed. Cir. 1995).

In the instant case, Currie et al. does not direct one skilled in the art to make the instantly claimed compounds. No example in Currie et al. has a double bond in any position of the carbon chain. Therefore, one skilled in the art would not be lead to make the compounds of the instant invention based upon the teachings of Currie et al.

Hallinan et al. teaches that the compounds disclosed therein are preferably halogenated. (See e.g. column 4, lines 47-48; column 6, lines 59-65.) All of the exemplified compounds disclosed in Hallinan et al. are halogenated.

In contrast, *none* of the compounds of the instant invention are halogenated. Therefore, one skilled in the art would not be lead to combine the teachings of Hallinan et al. with the teachings of Currie et al. to arrive at the instantly claimed compounds.

III. Obviousness-type Double Patenting

Claims 1-28 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-202 of co-pending application serial number 09/952,888 in view or Currie et al.

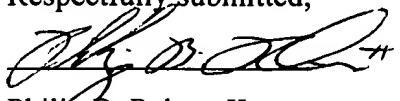
Without acquiescing to the propriety of such a rejection, applicants state that a provisional terminal disclaimer will be filed upon a finding of patentability of the claims in all other respects.

Conclusion

In view of the above, it is submitted that Claims 1-28 are in condition for allowance. Reconsideration of the rejections and objections is requested, and allowance of Claims 1-28 at an early date is solicited.

If the Examiner believes a telephonic interview with Applicant's representative would aid in the prosecution of this application, she is cordially invited to contact Applicant's representative at the below listed number.

Respectfully submitted,



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